



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,163	12/15/2003	John Kolbjoern Roedseth	DN2003204	4406
27280	7590	03/29/2006		
THE GOODYEAR TIRE & RUBBER COMPANY INTELLECTUAL PROPERTY DEPARTMENT 823 1144 EAST MARKET STREET AKRON, OH 44316-0001			EXAMINER JOHNSTONE, ADRIENNE C	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,163

Applicant(s)

ROEDSETH, JOHN KOLBJOERN

Examiner

Adrienne C. Johnstone

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 121503; 042805
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, drawn to a radial ply pneumatic tire including a circumferentially extending ring in a circumferentially extending tread groove, classified in class 152, subclass 196.
 - II. Claims 11-15, drawn to a run-flat tire assembly including the tire and a support ring both mounted on a wheel, the support ring having a radially outer continuous circumferential groove axially coincident with the tread circumferential groove, classified in class 152, subclass 158.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all of the particulars of the subcombination (radial carcass) are not recited in the combination. The subcombination has separate utility such as a radial ply tire mounted on a wheel without the support ring.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Nancy Krawczyk on November 18, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

5. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In claim 2 it is recited that the base of the circumferentially extending groove is radially inward of the reinforcing belts, however in claim 1 it is already required that the circumferentially extending ring in the groove is required to be radially inward of the reinforcing belts which necessitates having the base of the groove radially inward of the reinforcing belts.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

See paragraph 5 above: it is not clear how the circumferentially extending ring in the groove is radially inward of the reinforcing belts as required in claim 1 without the base of the

circumferentially extending groove also being radially inward of the reinforcing belts, thus rendering claim 2 redundant.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the state of the art exemplified by Boileau (3,830,273), Gerard et al. (5,421,390), Gerard et al. (5,645,658), Hammond et al. (5,685,927), and European Patent Application 0 465 786 A1, in view of Palmer (1,293,528), Murray (2,691,335), French Patent 607.026, and Japanese Patent Application 5-229303 A taken with Japanese Patent Application 5-229302 A.

The only difference between the prior art tire and the claimed tire is the positioning of the circumferentially extending ring in rather than under the circumferentially extending groove, as evidenced by Boileau (embodiment of the sole figure), Gerard et al. '390 (embodiment of Figure 1), Gerard et al. '658(embodiment of Figure 1), Hammond et al. (embodiment of Figure 2), and European Patent Application 0 465 786 A1 (embodiments of Figures 1-6) for example; however, both of these positions for such circumferentially extending rings are well known alternatives in the art, as evidenced by Palmer (embodiments of Figures 1 and 5), Murray (embodiments of Figures 1-7), French Patent 607.026 (embodiment of Figure 1, soft rubber D is optional, determined through oral translation), and Japanese Patent Application 5-229303 A (embodiment of the sole figure with translation) taken with Japanese Patent Application 5-229302 A (embodiment of Figure 2 with

abstract) for example. It would therefore have been obvious to one of ordinary skill in the art to provide such well known alternative positioning of the circumferentially extending ring in rather than under the circumferentially extending groove in the above prior art tire. As to claim 3, Gerard et al. '390 discloses an exemplary groove depth of 24 mm in a tire having a section height of 106 mm (23% of the tire section height). As to claims 6 and 7, the prior art tire may have a plurality of the circumferentially extending grooves having the circumferentially extending ring (Boileau col. 1 line 62 - col. 3 line 8; Gerard et al. '390 col. 1 line 33 - col. 3 line 11; Hammond et al. col. 2 line 41 - col. 3 line 40).

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the state of the art exemplified by Boileau (3,830,273), Gerard et al. (5,421,390), Gerard et al. (5,645,658), Hammond et al. (5,685,927), and European Patent Application 0 465 786 A1, in view of Palmer (1,293,528), Murray (2,691,335), French Patent 607.026, and Japanese Patent Application 5-229303 A taken with Japanese Patent Application 5-229302 A as applied to claims 1-9 above, and further in view of Japanese Patent Application 8-318715 A and German Utility Model DE 296 07 231 U1.

It is well known to provide reflective or fluorescent material in tread grooves in order to improve safety, as evidenced by Japanese Patent Application 8-318715 A (abstract, figures) and German Utility Model DE 296 07 231 U1 (abstract, figures) for example; it would therefore have been obvious to one of ordinary skill in the art to provide the circumferentially extending rings in the circumferentially extending grooves of the above tire with such well known reflective or fluorescent material in order to improve safety.

Art Unit: 1733

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (571) 272-1218. The examiner can normally be reached on Monday-Friday, 10:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adrienne Johnstone

March 22, 2006

Adrienne C. Johnstone
Primary Examiner
Art Unit 1733

